

# Notice of Allowability

Application No.

10/617,760

Examiner

Kambiz Abdi

Applicant(s)

STEFIK ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 16 December 2004.
2. ☒ The allowed claim(s) is/are 70,73,79-82,84-86 and 98-144.
3. ☒ The drawings filed on 14 July 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 4 November 2004
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_



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### DETAILED ACTION

1. Text of all the office actions previously forwarded to the applicant as well as all the responses to such office actions has been incorporated by reference.

- Claims 1-69, 71-72, 74-78, 83, and 87-97 have been canceled.
- Claims 70, 73, and 80-81 have been amended.
- New Claims 103-144 have been added.
- Claims 70, 73, 79-82, 84-86, and 98-144 have been allowed.

### *Examiner's Amendment*

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in an interview with attorney Carlos R. Villamar and Bijan Tadayon conducted in person on 7 December 2004.

The examiner under agreement by the attorney representing the applicant has amended independent claim 70 in addition to dependent claims 73, and 80. Also canceling claims 71-72, 74-78, 83, and 87-97 and adding claims 103-144.

The claims in the application has been amended as follow:

70. (Currently amended) A digital work recorded on a computer-readable media for use within a system having at least one non-centralized repository for enforcing use of digital content in accordance with usage rights associated with the digital content, said digital work comprising one or more computer-readable instructions for causing one or more computer processors to perform the steps of:

~~digital content~~ electronically recorded recording digital content on a first media portion and the digital content being capable of being rendered by a rendering engine; and

~~usage rights~~ electronically recorded recording usage rights on a second media portion and the usage rights being associated with said digital content, said usage rights specifying a manner of use by which as to how a non-centralized repository will permit use of the digital content, said usage rights including symbols selected from a set of predetermined symbols which define a valid sequence of

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symbols that are interpreted by the non-centralized repository to indicate the manner of use for enforcing use of digital content,

wherein said usage rights also specify one or more conditions which must be satisfied before the manner of use may be exercised,

said conditions include symbols selected from a set of predetermined symbols to define a valid sequence of symbols that are interpreted by the non-centralized repository to indicate the conditions,

the manner of use can include means for specifying how an authorized party is able to render the digital content, how an authorized party can permit the digital content to be used to create a new digital work, how an authorized party is able to make a back-up copy of the digital content, how an authorized party is able to conceal the digital content on a device on which the digital content is stored, and how an authorized party is able to delete the digital content from a device on which the digital content is stored, and

the usage rights identify rendering devices upon which the digital content is authorized to be rendered.

71-72. (Cancelled)

73. (New) The digital work as recited in ~~claim 72~~ claim 70, wherein the conditions include a set of default conditions.

74-78. (Cancelled)

79. (Previously presented) The digital work as recited in claim 70, wherein the digital content is a software program.

80. (Currently amended) The digital work as recited in claim 79, wherein the manner of use specifies ~~the manner by which~~ how an authorized party is able to install the software program.

81. (Currently amended) The digital work as recited in claim 79, wherein the manner of use specifies ~~the manner by which~~ how an authorized party is able to uninstall the software program.

82. (Previously presented) The digital work as recited in claim 70, wherein the usage rights comprise a revenue identifier for identifying a revenue owner of the digital work.

83. (Cancelled)

84. (Previously presented) The digital work as recited in claim 70, wherein the symbols are codes.

85. (Previously presented) The digital work as recited in claim 70, wherein the symbols are identifiers.

86. (Previously presented) The digital work as recited in claim 70, wherein the symbols are parameters.

87-97. (Cancelled)

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98. (Previously presented) A digital work as recited in claim 70, wherein the first media portion and the second media portion are parts of a same computer readable media.

99. (Previously presented) A digital work as recited in claim 70, wherein the first media portion and the second media portion are parts of different computer readable media.

100. (Previously presented) A digital work as recited in claim 70, wherein said content comprises a contents file and said usage rights comprise a description tree file.

101. (Previously presented) A digital work as recited in claim 70, wherein said content and said usage rights are stored on the same device.

102. (Previously presented) A digital work as recited in claim 70, wherein said content and said usage rights are stored on different devices.

103. (New) A digital work as recited in claim 70, wherein said usage rights are stored on an optical disk.

104. (New) A digital work as recited in claim 70, wherein said usage rights are stored on a removable storage device.

105. (New) A digital work as recited in claim 70, wherein said digital content is stored on an optical disk.

106. (New) A digital work as recited in claim 70, wherein said digital content is stored on a removable storage device.

107. (New) A method for enforcing use of digital content in accordance with usage rights associated with the digital content for use within a system having at least one non-centralized repository, said method comprising:

electronically recording digital content on a first media portion and the digital content being capable of being rendered by a rendering engine; and

electronically recording usage rights on a second media portion and the usage rights being associated with said digital content, said usage rights specifying a manner of use as to how a non-centralized repository will permit use of the digital content, said usage rights including symbols selected from a set of predetermined symbols which define a valid sequence of symbols that are interpreted by the non-centralized repository to indicate the manner of use for enforcing use of digital content,

wherein said usage rights also specify one or more conditions which must be satisfied before the manner of use may be exercised,

said conditions include symbols selected from a set of predetermined symbols to define a valid sequence of symbols that are interpreted by the non-centralized repository to indicate the conditions,

the manner of use can include means for specifying how an authorized party is able to render the digital content, how an authorized party can permit the digital content to be used to create a new digital

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work, how an authorized party is able to make a back-up copy of the digital content, how an authorized party is able to conceal the digital content on a device on which the digital content is stored, and how an authorized party is able to delete the digital content from a device on which the digital content is stored, and

the usage rights identify rendering devices upon which the digital content is authorized to be rendered.

108. (New) The method as recited in claim 107, wherein the conditions include a set of default conditions.

109. (New) The method as recited in claim 107, wherein the digital content is a software program.

110. (New) The method as recited in claim 109, wherein the manner of use specifies how an authorized party is able to install the software program.

111. (New) The method as recited in claim 109, wherein the manner of use specifies how an authorized party is able to uninstall the software program.

112. (New) The method as recited in claim 107, wherein the usage rights comprise a revenue identifier for identifying a revenue owner of the digital work.

113. (New) The method as recited in claim 107, wherein the symbols are codes.

114. (New) The method as recited in claim 107, wherein the symbols are identifiers.

115. (New) The method as recited in claim 107, wherein the symbols are parameters.

116. (New) A method as recited in claim 107, wherein the first media portion and the second media portion are parts of a same computer readable media.

117. (New) A method as recited in claim 107, wherein the first media portion and the second media portion are parts of different computer readable media.

118. (New) A method as recited in claim 107, wherein said content comprises a contents file and said usage rights comprise a description tree file.

119. (New) A method as recited in claim 107, wherein said content and said usage rights are stored on the same device.

120. (New) A method as recited in claim 107, wherein said content and said usage rights are stored on different devices.

121. (New) A method as recited in claim 107, wherein said usage rights are stored on an optical disk.

122. (New) A method as recited in claim 107, wherein said usage rights are stored on a removable storage device.

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123. (New) A method as recited in claim 107, wherein said digital content is stored on an optical disk.

124. (New) A method as recited in claim 107, wherein said digital content is stored on a removable storage device.

125. (New) A computer program product including one or more computer-readable instructions embedded in a computer readable medium for causing one or more computer processors to perform the steps recited in claim 107.

126. (New) A system including at least one non-centralized repository for enforcing use of digital content in accordance with usage rights associated with the digital content, said system comprising:

means for electronically recording digital content on a first media portion and the digital content being capable of being rendered by a rendering engine; and

means for electronically recording usage rights on a second media portion and the usage rights being associated with said digital content, said usage rights specifying a manner of use as to how a non-centralized repository will permit use of the digital content, said usage rights including symbols selected from a set of predetermined symbols which define a valid sequence of symbols that are interpreted by the non-centralized repository to indicate the manner of use for enforcing use of digital content,

wherein said usage rights also specify one or more conditions which must be satisfied before the manner of use may be exercised,

said conditions include symbols selected from a set of predetermined symbols to define a valid sequence of symbols that are interpreted by the non-centralized repository to indicate the conditions,

the manner of use can include means for specifying how an authorized party is able to render the digital content, how an authorized party can permit the digital content to be used to create a new digital work, how an authorized party is able to make a back-up copy of the digital content, how an authorized party is able to conceal the digital content on a device on which the digital content is stored, and how an authorized party is able to delete the digital content from a device on which the digital content is stored, and

the usage rights identify rendering devices upon which the digital content is authorized to be rendered.

127. (New) The system as recited in claim 126, wherein the conditions include a set of default conditions.

128. (New) The system as recited in claim 126, wherein the digital content is a software program.

129. (New) The system as recited in claim 128, wherein the manner of use specifies how an authorized party is able to install the software program.

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130. (New) The system as recited in claim 128, wherein the manner of use specifies how an authorized party is able to uninstall the software program.

131. (New) The system as recited in claim 126, wherein the usage rights comprise a revenue identifier for identifying a revenue owner of the digital work.

132. (New) The system as recited in claim 126, wherein the symbols are codes.

133. (New) The system as recited in claim 126, wherein the symbols are identifiers.

134. (New) The system as recited in claim 126, wherein the symbols are parameters.

135. (New) A system as recited in claim 126, wherein the first media portion and the second media portion are parts of a same computer readable media.

136. (New) A system as recited in claim 126, wherein the first media portion and the second media portion are parts of different computer readable media.

137. (New) A system as recited in claim 126, wherein said content comprises a contents file and said usage rights comprise a description tree file.

138. (New) A system as recited in claim 126, wherein said content and said usage rights are stored on the same device.

140. (New) A system as recited in claim 126, wherein said content and said usage rights are stored on different devices.

141. (New) A system as recited in claim 126, wherein said usage rights are stored on an optical disk.

142. (New) A system as recited in claim 126, wherein said usage rights are stored on a removable storage device.

143. (New) A system as recited in claim 126, wherein said digital content is stored on an optical disk.

144. (New) A system as recited in claim 126, wherein said digital content is stored on a removable storage device.

***Allowable Subject Matter***

3. Claims 70, 73, 79-82, 84-86, and 98-144 are allowed over the prior art of record.

4. The following is an examiner's statement of reason for allowance:

The closest prior art of record is U.S. Patent No. 5,260,999 to Robert M. Wyman et al., U.S. Patent No. 5,138,712 to John R. Corbin, U.S. Patent No. 5,255,106 to Peter D. Castro, and U.S. Patent No. 5,646,992 to Ronald J. Subler. Wyman provides a method and system to control usage policy of a digital product based on licensed terms, conditions, and authorization. Wyman is directed towards

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distribution of digital products and licensing the same either in full or in part. Wyman also discloses how a rights management system and method can add terms and condition to a licensed digital software, content, or data. Corbin discloses a method and system of creating a new version or upgrade to a digital work, as well as deleting the digital work from a system. Castro discloses how a digital work can be concealed, in addition Subler teaches the installing and uninstalling of software and digital works. Finally Johnson discloses a method and system to create multiple conditions of usage for different versions of the same digital works. The general states of all of the mentioned prior arts of records disclose method and system to track and bill usage of digital products. The closest foreign prior art of record is European Patent No. GB-2236604 A to John R Corbin, and the NPL cited by the applicant titled "Digital Rights Management Technology" by Weber, R. published in October 1995, which they relate to the general state of the art. On the other hand, applicants claimed invention is directed towards creating a composite digital works that have attached usage rights.

In regards to independent claims 70, 107, and 126, the closes prior art of record when taken either individually or in combination with other prior art of record fails to tech or suggest the step of controlling the manner of use of the digital work in accordance with the manner of use specified by said usage right if the requester possesses the digital rights, wherein;

electronically recording usage rights on a second media portion and the usage rights being associated with said digital content, said usage rights specifying a manner of use as to how a non-centralized repository will permit use of the digital content, said usage rights including symbols selected from a set of predetermined symbols which define a valid sequence of symbols that are interpreted by the non-centralized repository to indicate the manner of use for enforcing use of digital content,

wherein said usage rights also specify one or more conditions which must be satisfied before the manner of use may be exercised,

said conditions include symbols selected from a set of predetermined symbols to define a valid sequence of symbols that are interpreted by the non-centralized repository to indicate the conditions,

the manner of use can include means for specifying how an authorized party is able to render the digital content, how an authorized party can permit the digital content to be used to create a new digital



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work, how an authorized party is able to make a back-up copy of the digital content, how an authorized party is able to conceal the digital content on a device on which the digital content is stored...

Claims 73, 79-82, 84-86, and 98-106 are dependent upon claim 70, claims 108-125 are dependent on independent claim 107 and claims 127-144 are dependent on independent claim 126 thus have all the limitations of independent claims 70, 107, and 126 and are allowable for the same reason.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

Kambiz Abdi  
Examiner  
January 6, 2005

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